

REMARKS

I. Summary of Office Action

Claims 1-12 are now pending in the application.

The Examiner rejected claims 1-6, 9, and 10 under 35 U.S.C. § 102(e) as being anticipated by Stanbach Jr. et al. U.S. Patent No. 6,449,657 (hereinafter "Stanbach").

The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Stanbach in view of Chen et al. U.S. Patent No. 6,857,024 (hereinafter "Chen").

The Examiner rejected claims 8 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Stanbach in view of Gerace U.S. Patent No. 5,991,735 (hereinafter "Gerace").

The Examiner rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Stanbach in view of Chen and in further view of Gerace.

II. Summary of Applicants' Reply

Applicants have amended claims 1, 4, 5, 6, 8, 9, 11, and 12 in order to particularly point out and distinctly claim the subject matter which applicants regard as their invention. Applicants have also cancelled dependent claims 2 and 3.

The Examiner's rejections of the claims are respectfully traversed.

Reconsideration of this application is respectfully requested.

III. The Rejection of Independent Claims 1, 10 and 13 Under 35 U.S.C. § 102(b)

The Examiner rejected each of pending independent claims 1 and 9 under 35 U.S.C. § 102(b) as being unpatentable over Stanbach. The Examiner's rejection of these claims under this section is respectfully traversed.

Applicants respectfully submit that, contrary to the Examiner's contention, each of independent claims 1 and 9 is allowable for at least the reasons set forth below.

A. Applicants' Independent Claims are Allowable Over Stanbach

Applicants' independent claim 1 relates to a method for creating a message campaign, where the message campaign provides a narrative framework for creating a personalized advertisement for an intended audience and where the personalized advertisement is based on

user profile data of the intended audience. As defined by independent claim 1, this method includes:

- creating at least one default message example of a personalized advertisement;
- delineating general characteristics of members of said intended audience and creating a set of target entity qualification data factors for use in database searches to acquire a list of entities to which a said personalized advertisement is to be distributed;
- creating an entity profile template including a substantially complete definition of information about each of said entities that is to be acquired by said database search;
- constructing a message template that includes a plurality of media segment slots, wherein said media segment slots comprise video segment slots and audio segment slots; and
- constructing a message resource library that includes a plurality of media segments including video segments and audio segments, wherein each video segment is selectable for insertion into at least one of said video segment slots and each audio segment is selectable for inserting into at least one of said audio segment slots, and wherein at least one of said audio and video segments is selectable for a same one of said segment slots of said message template.

Stanbach, on the other hand, discusses methods and systems for providing domain name services. (*See, e.g.*, Stanbach, column 3, lines 55-56.) More particularly, as explained in column 9, line 18 through column 15, line 26 and FIG. 7, in Stanbach, a system that inserts or attaches completed advertisements (*e.g.*, advertisements 736 and 740 of FIG. 7) into an e-mail message.

Applicants respectfully submit that, contrary to the Examiner's contention, Stanbach does not show or suggest the system defined by independent claim 1 for at least the reasons set forth below.

(i) Stanbach Does Not Show or Suggest a Message Template

As recited above, applicants' claim 1 requires "a message template that includes a plurality of media segment slots, wherein said media segment slots comprise video segment slots and audio segment." As explained in applicants' specification, "[t]he narrative framework for the final personalized message is a story as defined by a message campaign. The message campaign includes a message template and a collection of media segments." The media segments (*e.g.*, audio, video, background, animation, graphs, voice, etc.) are selected and then

assembled to produce the final personalized message at assembly time. (*See, e.g.*, Applicants' specification, page 6, lines 8-19.)

FIG. 7 of Stanbach (or any other portion of Stanbach) does not show or suggest "a message template" that includes video segment slots and audio segment slots. Rather, Stanbach merely shows a system that inserts or attaches completed advertisements into an e-mail message.

Accordingly, applicants respectfully submit that Stanbach fails to show or suggest a system including, among other things, "a message template that includes a plurality of media segment slots, wherein said media segment slots comprise video segment slots and audio segment."

(ii) Stanbach Does Not Show or Suggest a Plurality of Media Segments

As recited above, applicants' claim 1 requires "a plurality of media segments including video segments and audio segments, wherein each video segment is selectable for insertion into at least one of said video segment slots and each audio segment is selectable for inserting into at least one of said audio segment slots, and wherein at least one of said audio and video segments is selectable for a same one of said segment slots of said message template." Stanbach also does not show or suggest this element of applicants' claimed invention.

As explained above, Stanbach does not show or suggest a message template that includes audio segment slots and video segment slots. In fact, the e-mail of Stanbach is not capable of including audio and video segment slots, where at least one video segment slot and at least one audio segment slot overlap. Instead, the advertisement of Stanbach "is presented to the intended recipient, by either inserting the advertisement into the e-mail message body, or attaching the advertisement to the e-mail message, or inserting the advertisement in or attaching the advertisement to a subsequent e-mail or other message transmitted to the intended recipient at a later time." (*See* Stanbach, col. 10, lines 5-10.) Stanbach makes no mention of inserting video and audio segments into video segment slots or audio segment slots. Thus, a plurality of media segments (*e.g.*, audio segments or video segments) cannot be inserted into the message of Stanbach.

Accordingly, because Stanbach fails to show or suggest any use of "video segment slots" or "audio segment slots," applicants respectfully submit that Stanbach must also fail to show or

suggest a system including “a plurality of media segments including video segments and audio segments, wherein each video segment is selectable for insertion into at least one of said video segment slots and each audio segment is selectable for inserting into at least one of said audio segment slots, and wherein at least one of said audio and video segments is selectable for a same one of said segment slots of said message template.”

In view of the foregoing, applicants respectfully submit that independent claim 1 is allowable over Stanbach. Therefore, applicants respectfully request that the rejection of claim 1 be withdrawn by the Examiner.

Similarly, the remaining independent claim 9 is allowable for at least the same reasons. Therefore, applicants respectfully request that the rejection of independent claim 9 also be withdrawn by the Examiner.

IV. The Rejection of Dependent Claims 2-8, 10, and 11 Under 35 U.S.C. §§ 102(e) and 103(a)

The Examiner rejected dependent claims 2-6 and 10 under 35 U.S.C. § 102(e) as being anticipated by Stanbach. The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Stanbach in view of Chen. The Examiner rejected claims 8 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Stanbach in view of Gerace. Applicants respectfully traverse the Examiner’s rejections.

Applicants respectfully submit that claims 2-8, 10, and 11, each of which depends from one of independent claims 1 and 9, are allowable for at least the same reasons that the independent claims are patentable as set forth above. Therefore, applicants respectfully request that the Examiner withdraw the rejections of claims 2-8, 10, and 11.

V. The Rejection of Independent Claims 12 Under 35 U.S.C. § 103(a)

The Examiner rejected independent claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Stanbach in view of Chen in further view of Gerace. The Examiner's rejection of these claims under this section is respectfully traversed.

Applicants respectfully submit that the amendments made to independent claims 1 and 9 were also made to independent claim 12. Thus, independent claim 12 is allowable for at least the same reasons that independent claims 1 and 9 are patentable as set forth above in Section IV.

In addition to the reasons set forth in section IV, the § 103 rejection should therefore be withdrawn for an additional, independent reason. *See* MPEP § 2143.

The Examiner has failed to provide the necessary motivation to combine Stanbach with Chen and Gerace. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references."). *See* also MPEP §§ 2142 and 2143.01. It is well-settled that an Examiner can "satisfy this burden only by showing some objective teaching . . . that would lead [one of ordinary skill in the art] to combine the relevant teachings of the references." *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Instead of providing an objective teaching of a motivation to combine Stanbach with Chen and Gerace, however, the Examiner merely concludes that it would be obvious to combine Stanbach with Chen and Gerace "because it would advantageously . . . further delineate said general characteristics of said members of intended audience, thereby creating [a] precise targeted advertisements" and "because it would advantageously allow a user to select an appropriate theater based on user's preferences in time and the location of the show." (Office Action, pages 6-7.) But such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence' of a motivation to combine. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by *In re Gartside*, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000). In addition, relying solely on applicants' "disclosure as a blueprint for piecing together the prior art to defeat patentability" is insufficient as a matter of law. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999); *see* also *In re Lee*, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) ("The

factual inquiry of whether to combine references must be thorough and searching”); MPEP § 2143.

In view of the foregoing reasons, applicants respectfully submit that independent claim 12 is allowable over Stanbach in view of Chen in further view of Gerace. Accordingly, applicants respectfully request that the rejection of claim 12 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely applicants' best attempt at providing one or more definitions of what the applicants believe to be suitable patent protection. In addition, the present claims provide the

intended scope of protection that applicants are seeking for this application. Therefore, no estoppel should be presumed, and applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

AUTHORIZATION

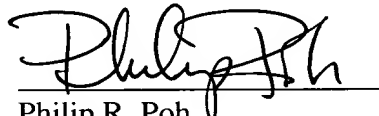
The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219.

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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